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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------|-------------|----------------------|---------------------|------------------|
| 10/791,386 | 03/03/2004 | Minoru Sakai | FS-F03230-01 | 3510 |
| 37398 | 7590 | 08/14/2007 | EXAMINER | |
| TAIYO CORPORATION | | | CHEA, THORL | |
| 401 HOLLAND LANE | | | | |
| #407 | | | | |
| ALEXANDRIA, VA 22314 | | | | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1752 | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/791,386

Applicant(s)

SAKAI ET AL.

Examiner

Thorl Chea

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20070621.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This office action is responsive to the communication on May 29, 2007; claims 1-14 are pending in this instant application; claims 15-35 have been canceled.

The rejections, paragraphs 1-6, set forth in the office action on December 29, 2007 are withdrawn in view of the amendment on May 29, 2007.

2. The certified English translation of the foreign priority document (Japanese Patent Application No. 2003-058549) obviates the rejections under 35 USC 103(a) as being unpatentable over Oyamada et al (US 2004/0038156A1) or Yamane et al (US 2004/0058281) in combination with Harai et al (US 6,475,715B2) set forth in paragraph 10 in the office action on December 29, 2006; and the Terminal Disclaimer on May 29, 2007 obviates the provisionally rejected the claimed invention over that of the copending application serial no. 10/448,280; and the claimed invention rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of the US Patent No. 7,105,282B2. The rejections are withdrawn.

3. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1752

5. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Toya et al (US Patent No. 6,335,153), Stoebe et al (US 2003/0081956), and Harai et al (US 6,475,715B2).

Toya et al discloses an image forming apparatus including exposed portion (16) equipped with a laser beam scanner and heat development portion (18) with conveying roller pairs of the conveying section 17 for developing a photothermographic material. See Fig 1; page 22, lines 25-60, and the polyhalogenate compound in column 29, lines 14-65. Stoebe et al discloses the process of forming an image using photothermal film using a compact thermal development apparatus wherein the light-exposure portion annexed to the thermal development portion. See Fig.4, wherein light source generated by light source (9) and thermal film processing using radiant energy source (22). Harai et al disclose a photothermographic material used in the process of the claimed invention. See the composition of the material which contains the polyhalogenate compound of the present invention in column 37-40, claims 1-17.

The process claimed in the present claimed invention is directed to the process for forming an image using a photothermographic material and a heat-development apparatus. The photothermographic material containing a polyhalogenate compound have been known and taught in Harai et al. The apparatus having the scanning exposure portion and the heat-development portion is taught in Toya et al such as shown above, but Toya et al do not disclose a distance between the scanning exposure position and an insertion part of the thermal portion is 50 cm or less. However, it has been known in Stoebe et al to provide a heat-development apparatus with a light-exposure portion annexed to the thermal development portion to provide a compact heat-development apparatus. Therefore, it would have been obvious to the worker of

Art Unit: 1752

ordinary skill in the art to reconfigure heat-development apparatus taught by Toya et al by placing the light-exposure portion annexed to the thermal development portion such as taught in Stoebe et al to render the material compact, and thereby using to provide an image using the known material such as taught in Harai et al, and thereby provide a process as claimed.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tch
2007-08-10


Thorl Chea
Primary Examiner
Art Unit 1752